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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DOUGLAS S. REEVES and SAMUEL H. CHRISTIE IV

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Appeal 2008-2675  
Application 09/691,347  
Technology Center 2400

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Decided: December 29, 2008

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Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-14, 20-29, and 33-36. Claims 15-19 and 30-32 have been cancelled. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

#### A. INVENTION

The invention at issue on appeal relates generally to authorizing communication services, and particularly, to using special authentication to arrange for such services over a network. Appellants summarize and mentioned as follows:

The present invention provides for a communication server of a service provider to authorize resource reservation for a communication session over a packet- switched network without requiring the communication server to know the identity of or significant details about the network elements providing the communication. The communication server is configured to provide secure authorization indicia to the terminal receiving or delivering information for the communication. The terminal presents the authorization indicia to one or more network elements involved in reserving resources for the communication. The network element or elements will use the authorization indicia to authorize resource reservation for the communication, and may forward the authentication to additional network elements involved in reserving resources for the communication.

(Spec. 3.)

#### B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method of authorizing communications comprising:
  - a) receiving a request for authorization to establish a communication with a destination terminal from an origination terminal;
  - b) generating authorization indicia for the communication, the authorization indicia configured to enable reservation of resources for the communication; and
  - c) initially sending the authorization indicia to at least one of the originating and destination terminals to facilitate

reservation of resources for the communication, wherein the at least one of the originating and destination terminals receiving the authorization indicia will subsequently send the authorization indicia to at least one network element to reserve resources for at least a portion of the communication.

### C. REFERENCES

The Examiner relies on the following references as evidence:

Chang	US 6,058,113	May 2, 2000
Eriksson	US 6,661,806 B1	Dec. 9, 2003
		(filed Nov. 19, 1998)

### D. REJECTIONS

The Examiner makes the following rejection.

Claims 1-14, 20-29, and 33-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eriksson in view of Chang.

## II. ISSUE

Has the Examiner set forth a sufficient initial showing of obviousness?

## III. PRINCIPLES OF LAW

### 35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

#### IV. ANALYSIS

From our review of the Examiner's Answer, we find that the Examiner has presented a confusing initial showing of obviousness. First, at pages 3-5 of the Answer, the Examiner presents a first interpretation of the teachings of Eriksson relying upon column 3, lines 3-10, to show the receiving a request for authorization and generating authorization indicia. The Examiner parenthetically summarizes the quotations from the reference in the statement of the rejection. We find the Examiner's parenthetical summaries to be loose interpretations of the express teachings of Eriksson.

We consider the Examiner's second interpretation of the teachings of Eriksson (at pages 14-17 of the Answer) where the Examiner states at page 16 that "the request for the reservation and the usage of tickets is equivalent to applicant's authentication [sic, authorization] indicia." Here, the Examiner seems to equate the return ticket M, which is after the reservation is granted, as the authorization indicia.

For the reasons stated in the Brief, we agree with Appellants' reasoned conclusion that the ticket cannot be the authorization indicia since it is generated after the reservation is granted. (See also Eriksson at column 3, ll. 36-62).

With respect to the Examiner's first presented position at page 4 of the Answer, the Examiner equates the router AR in step 1 of the method of Figure 3 as the receiving a request for authorization step (a) of the claimed invention, but the reservation at router AR already would include the listed parameters. Therefore, there would be no step of generating authorization indicia for the communication as recited in step (b) of independent claim 1, as the Examiner has correlated the claimed invention. Therefore, the

Examiner's correlation fails since the authorization indicia is generated prior to receiving the request.

Additionally, with respect to the Examiner's combination of Eriksson and Chang, the Examiner relies upon column 2, lines 8-12 of Chang, as an express motivation for the combination. We find the Examiner's reliance upon the specific teachings at column 2 of Chang to be taken out of context with respect to the teachings of Eriksson with respect to establishing a reservation using authorization indicia. Therefore, we find the Examiner's line of reasoning for the combination to be flawed. Furthermore, we find Examiner's attempt to correlate the teachings of Eriksson to be similarly flawed. Therefore, we find that the Examiner has not set forth a sufficient initial showing of obviousness of independent claims 1, 5, 9, 20, 24, 27, and 33.

#### V. CONCLUSION

For the aforementioned reasons, Appellants have shown that the Examiner has not established a prima facie case of obviousness.

#### VI. ORDER

We reverse the obviousness rejections of claims 1-14, 20-29, and 33-36.

#### REVERSED

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